# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/037,593 | 10/19/2001 | Matthew P. Kulig | 60022210-0157 (1004.P001U | 6376 |

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| EXAMINER |
|---|
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| ART UNIT | PAPER NUMBER |
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| 2157 | |

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 10/037,593 | KULIG ET AL. |
| | Examiner | Art Unit | |
| | Barbara N. Burgess | 2157 | |

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on <u>22 October 2007</u>.

2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) <u>1-3,5-19,21-27 and 54-59</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-3,5-19,21-27 and 54-59</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

## DETAILED ACTION

The Office Action is in response to Request for Continuation Examination (RCE) filed

October 22, 2007.  Claims 1-3, 5-19, 21-27, 54-59 are presented for further

examination.

### *Claim Rejections - 35 USC § 102*

1.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.      Claims 1-2, 5-13-19, 21-27, 54-59 are rejected under 35 U.S.C. 102(e) as being

anticipated by Lachman, III et al. (hereinafter "Lach", US Patent Publication

2002/0166063 A1).

As per claim 1, Lach discloses a system for controlling transmission of data

packets through an information network, each data packet comprising a content portion,

a header, and a trailer, said system comprising:

- A Regional Transaction Processor (RTP) (paragraphs [0070-0072]);

- Coupled to the RTP, a data Enabling Device (DED) containing content match

  information and operable to:

  a.      Receive data packets from the information network

          (paragraphs [0110-0111]);

    b.     Detect when information within the content portions of a data packet is

substantially similar to content match information (paragraphs [0112, 0117]);

    c.     when information within the content portion of a data packet is

substantially similar to content match information, initiate issuance of a

message to a user workstation and invoke the RTP to process a

transaction (paragraphs [0101, 0111, 0120-0121, 0124]).


As per claim 2, Lach discloses the system as set forth in claim 1, wherein the

transaction is based on control information associated with the content match

information (paragraphs [0017, 0020]).


As per claim 5, Lach discloses the system, as set forth in claim 1, wherein the

RTP comprises a network server and a database, and is operable to process requests

for content (paragraphs [0069-0071])


As per claim 6, Lach discloses the system, as set forth in claim 1, wherein the

DED is located at a network access point (NAP) (paragraph [0069]).


As per claim 7, Lach discloses the system, as set forth in claim 1, further

comprising a plurality of DEDS along a network route, wherein each DED is operable to

communicate with at least one of the other DEDS (paragraph [0116]).

As per claim 8, Lach discloses the system, as set forth in claim 7, wherein the plurality of DEDS include a first DED that generates a message and at least one intermediate DEDS operable to forward the message to the DED closest to the user workstation along the network route (paragraph 0116]).

As per claim 9, Lach discloses the system, as set forth in claim 7, wherein the plurality of DEDS are operable to communicate with each other to prevent transmitting more than one message for the same data packet through the network route (paragraph [0117]).

As per claim 10, Lach discloses the system, as set forth in claim wherein the RTP transmits a Release Content or Cease-content message to the DED, based on whether a data packet was authorized to be downloaded to the workstation (paragraph [0190]).

As per claim 11, Lach discloses the system, as set forth in claim 1, wherein the DED includes Field Programmable Gate Arrays (FPGAS) (paragraphs [0065-0066]).

As per claim 12, Lach discloses the system, as set forth in claim 11, wherein the FPGAS are reprogrammed over the network to perform a content matching function (paragraphs [0065, 0067, 0081]).

As per claim 13, Lach discloses the system, as set forth in claim 11, wherein a portion of the DED is dynamically reprogrammed and the DED is operable to continue processing the data packets during the dynamic reprogramming (paragraph [0114]).

As per claim 14, Lach discloses the system, as set forth in claim 1, further comprising a Central Storage and Backup System (CSBS) operable to communicate with the RTP, to monitor operation of the RTP, and to store transaction information (paragraph [0129]).

As per claim 15, Lach discloses the system, as set forth in claim 14, wherein the CSBS is operable to transmit information to reprogram the DED to communicate with another RTP (paragraph [0114]).

As per claim 16, Lach discloses the system, as set forth in claim 1, further comprising a content matching server operable to store content match information, to communicate with the DED, and to transmit the content match information to the DED (paragraphs [0098, 0109-0110]).

As per claim 17, Lach discloses the system, as set forth in claim 1, wherein the DED is operable to suspend transmission of the data packets through the information network until a response to a prompt is received (paragraph [0111]).

As per claim 18, Lach discloses a method, an apparatus, and a computer

program product for controlling transmission of identifiable content over an information

network, said method comprising:

- Providing content match information for the content to a DED, wherein the DED is

  located in the information network along a transmission path of a plurality of data

  packets, each data packet having a header, a content portion, and a trailer

  (paragraphs [0020, 0110]);

- Receiving data packet in the DED (paragraphs [0110-0111]);

- Looking for content match information in the content portions of the data packets

  (paragraphs [0112, 0117]);

- when content match information is detected in a content portion of a data packet,

  issuing a prompt to a user workstation (paragraphs [0101, 0111, 0120-0121, 0124]).


As per claim 19, Lach discloses the method, an apparatus, and a computer

program product as set forth in claims 18 and 28, wherein the prompt is based on

control information associated with the content match information (paragraphs [0017,

0020]).


As per claim 21, Lach discloses the method, an apparatus, and a computer

program product as set forth in claims 18, 28, 36, further comprising: processing a

transaction based on a user's response to the prompt (paragraph [0172]).

As per claim 22, Lach discloses the method, an apparatus, and a computer program product as set forth in claims 18, 28, 36, further comprising transmitting a message among a plurality of DEDS along the transmission path to prevent transmitting more than one prompt for the same data packet (paragraph [0117]).

As per claim 23, Lach discloses the method, an apparatus, and a computer program product as set forth in claims 18, 28, 39, further comprising: processing a transaction based on a user response to the prompt, and transmitting a Release Content or Cease Content message to the DED based on whether content was authorized to be downloaded to the workstation as part of the transaction (paragraph [0190]).

As per claim 24, Lach discloses the method, an apparatus, and a computer program product as set forth in claims 18, 28, further comprising: reprogramming a portion of the DED to detect different content match information (paragraph [0114]).

As per claim 25, Lach discloses the method, an apparatus, and a computer program product as set forth in claims 18, 28, further comprising suspending transmission of a data packet through the information network until a user response to the prompt is received (paragraph [0111]).

As per claim 26, Lach discloses a computer program product comprising:

program instructions to implement the method of claim 18 (paragraphs [0064-0067]).


As per claim 27, Lach discloses a data signal comprising:

program instructions to implement the method of claim 18 (paragraphs [0064-0067]).


As per claim 54, Lach discloses the system, as set forth in claim 1, wherein the

DED is further operable to search the data packets for content match information to

determine whether transmission of data packets containing particular content should be

prevented, and when the DED finds such content match information, the DED prevents

further transmission of data packets containing said particular content, without

additional processing (paragraph 0087, 0090]).


As per claim 55, Lach discloses the system, as set forth in claim 1, wherein a

content provider supplies transaction instructions to the RTP for use when the DED

finds the content match information in a data packet (paragraphs [0082-0083]).


As per claim 56, Lach discloses the system, as set forth in claim 55, wherein the

instructions include transmitting a transaction prompt to the user workstation informing

of a price to pay for content in the packets, and allowing the user to accept or decline

purchase of the content (paragraph [0126]).

As per claim 57, Lach discloses the system, as set forth in claim 55, wherein the

instructions specify transmitting a prompt to inform a user that content infected with a

virus is attempting to be transmitted from or received by the workstation and that

transmission or reception of the virus is being halted (paragraph [0176]).


As per claim 58, Lach discloses the system, as set forth in claim 55, wherein the

instructions include transmitting a prompt to the user workstation to inform that content

subject to security control is attempting to be transmitted from or received to the user's

workstation, and that transmission or reception of the content is being halted (paragraph

[0169]).


As per claim 59, Lach discloses the system, as set forth in claim 55, wherein the

RTP tallies statistics regarding transmission of designated content (paragraph [0172]).


### Claim Rejections - 35 USC § 103

3.      The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.


4.      Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lachman,

III et al. (hereinafter "Lach", US Patent Publication 2002/0166063 A1) in view of May

(US Patent 5,710,757).

As per claim 3, Lach discloses the system, as set forth in claim 1.

Lach does not explicitly disclose wherein the DED is operable to detect when the data

packets include content match information at a rate proportional to the rate at which the

data packets are received by the DED.

However, in an analogous art, May discloses an electronic device setting a decoding

rate to be an address rate, then reads the address data at the address rate. The device

determines that the address data matches an address of the electronic device. The

device then adjusts the decoding rate to be a message rate different than the address

rate, where the message rate corresponds to the address (column 2, lines 11-25).

Therefore, one of ordinary skill in the art at the time the invention was made

would have found it obvious to incorporate or implement May's detecting when the one

or more data packets include content match information at a rate proportional to the rate

at which the data packets are received in Lach's system allowing service providers to

transmit and electronic device to process different types of messages at different rates.

### Response to Arguments

**The Office notes the following argument(s):**

(a)      Lachman III (US Patent Publication 2002/0166063 A1) claims priority to Lachman

I (US Provisional Patent Application serial no. 60/272,712) filed March 1, 2001. The

filing date of the instant application falls between Lachman III and the provisional

application. Any new matter in Lachman III cannot be used as prior art against the claims of the instant application.

(b)     Lachman I does not disclose user workstations nor does it disclose anything analogous to Applicant's RTP.

(c)     Lachman I does not disclose or suggest anything analogous to a DED operable to search data packets for content match information.

(d)     Lachman I does not prevent further transmission of any packets.

5.     Applicant's arguments filed have been fully considered but they are not persuasive.

**In response to:**

(a)     The provisional application, Lachman I (60/272,712), for which Lachman III (US Patent Application Publication 2002/0166063 A1) claims benefit discloses subject matter which is described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application (US Patent Publication 2002/0166063 A1) was filed, had possession of the claimed invention. Therefore, Lachman III can be used as prior art against the instant application. Therefore, the effective date of the patent is the provisional date of March 1, 2001.

(b)     Lachman III teaches triggering an "Alert" message, as well as providing attack reports and displaying "Warning" messages (paragraphs [0101, 0128, 0153]). Lachman III further teaches an offensive countermeasure server (RTP) which can provide a pathway for initiating an offensive countermeasure against attacker. This

server is connected to the A.N.T. system (DED) used to monitor data sent between the

host router and host server to detect attacks (paragraphs [0070-0071]).

Therefore, Lachman III indeed discloses user workstations and Applicant's RTP.

(c)     Lachman III teaches an A.N.T. system that analyzes packets to determine if they

match a signature of an attack type, or if they contain similar or matching data.  The

packet snifffing module of the system compares information within packets to detect

packets comprising similar or matching information (paragraphs [0073, 0081, 0098,

0100]).

Therefore, Lachman III undoubtedly discloses a DED operable to search data packets

for content match information.

(d)     Lachman III teaches the host router can deny or allow certain traffic to the host

network.  Packets that may part of an attack can be rejected from transmission

(paragraphs [0111, 0120]).

Therefore, Lachman III discloses preventing further transmission of packets.


### *Conclusion*

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Barbara N. Burgess whose telephone number is (571)

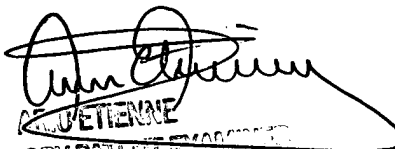272-3996.  The examiner can normally be reached on M-F (8:00am-4:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ario Ettinene can be reached on (571) 272-4001.  The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Barbara N Burgess
Examiner
Art Unit 2157

January 4, 2008